

### ***REMARKS***

This amendment is believed to be fully responsive to the examiner's office action. It is requested that matters as to form that have not been addressed in this response be held in abeyance until allowable subject matter is indicated. Reconsideration, further examination, entry of the above amendments, and allowance is respectfully requested in view of the above amendments which address the points in the Examiner's as follows:

#### ***Allowable Subject Matter***

Claim 4 has been found to be allowable provided that certain grounds for rejection under 35 U.S.C. § 112 were corrected. The applicant corrected these grounds for rejection, and claim 4 was not rejected in the office action of July 2, 2003. Accordingly, claim 4 stands allowed.

#### ***Claim Rejections -35 U.S.C. § 102***

The examiner rejected claims 1-3, 7-9 and 12-14 as being anticipated by Shine (5,577,711). Shine is a flashing removal tool. Flashing, as used in the Shine patent, is a material used in roofing to prevent water penetration through the roof and is typically used at valleys, chimneys, roof penetrations, eaves, rakes, skylights, ridges, and at roof-to-wall intersections on

the roof. Flashing and its removal has nothing to do with floor edgers or the adjustment of these devices.

As stated in M.P.E.P. § 2111.02, the determination of whether preamble recitations are structural limitations can be resolved only on review of the entirety of the application "to gain an understanding of what the inventors actually invented and intended to encompass by the claim."); *Pac-Tec Inc. v. Amerace Corp.*, 903 F.2d 796, 801, 14 USPQ2d 1871, 1876 (Fed. Cir. 1990).

The claim preamble must be read in the context of the entire claim. The determination of whether preamble recitations are structural limitations or mere statements of purpose or use "can be resolved only on review of the entirety of the [record] to gain an understanding of what the inventors actually invented and intended to encompass by the claim." *Corning Glass Works*, 868 F.2d at 1257, 9 USPQ2d at 1966. If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any *distinct definition of any of the claimed invention's limitations*, then the preamble is not considered a limitation and is of no significance to claim construction. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165

(Fed. Cir. 1999). See also *In re Stencel*, 828 F.2d 751, 4 USPQ2d 1071 (Fed. Cir. 1987).

The invention claimed here recites ``a leading gage surface'', ``an angle gage surface'', and ``a pair of wheel setting surfaces.'' The meaning of these terms can only be understood by the language recited in the preamble. Accordingly, appropriate weight should be given to the preamble as limitation. Here, the examiner has (inappropriately) given no weight to the preamble, and thus the examiner's rejection of claims 1-3, 7-9, and 12-14 is traversed.

The Shine reference does not enable those skilled in the art on how to make and use the claimed invention, and thus does not anticipate the claimed invention. "A claimed invention cannot be anticipated by a prior art reference if the allegedly anticipatory disclosures cited as prior art are not enabled." Amgen, Inc. v. Hoechst Marion Roussel, Inc., 314 F.3d 1313, 1354, 65 USPQ2d 1385, 1416 (Fed. Cir. 2003). See Bristol-Myers Squibb v. Ben Venue Laboratories, Inc., 246 F.3d 1368, 1374, 58 USPQ2d 1508, 1512 (Fed. Cir. 2001) ("To anticipate the reference must also enable one of skill in the art to make and use the claimed invention."); PPG Industries, Inc. v. Guardian Industries Corp., 75 F.3d 1558, 1566, 37 USPQ2d 1618, 1624 (Fed. Cir. 1996) ("To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter."). To anticipate under 35 U.S.C. 102(b) the reference must sufficiently describe the claimed

invention to have placed the public in possession of it. *Merck & Co. v. Marzall*, 197 F.2d 206, at 207 (U.S.App.D.C. 1952).

In this case, it is clear that the roofing tool of Shine does not enable anyone, regardless of how highly skilled, to make the disclosed and claimed tool, or to carry out the process claimed here.

Accordingly, weight should to the pending claim's preamble, and that the rejection on the basis of Shine and any other prior art be withdrawn.

#### CONCLUSION

In view of the above, it is submitted that the applicant has placed this application in condition for allowance. Further examination, abeyance of any remaining informalities, and reconsideration and withdrawal of the rejections and objections raised in the Examiner's Office Action is requested. Moreover, it is submitted that the claims are now in condition for allowance, and that allowance of the present application is in order and is also requested.

Should the Examiner deem that any further amendment is desirable to place this application in condition for allowance, the examiner is invited to telephone the undersigned at the number listed below.

Respectfully submitted this 3rd day of November, 2003,



Ramon L. Pizarro, Reg. No. 37207  
Attorney for Applicant  
3515 South Tamarac Drive, Suite 200  
Denver, Colorado 80237  
Telephone: (303) 779-9551  
Facsimile: (303) 689-9627

### CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, on this 3rd day of November, 2003.



Ramon L. Pizarro